



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/999,297 12/29/97 POOL

E 0090-001

TM02/0119

ROBERT G LEV
4766 MICHIGAN BOULEVARD
YOUNGSTOWN OH 44505

EXAMINER

AKERS, G

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

01/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/999,297

Applicant(s)

Pool et al

Examiner

Geoffrey Akers

Group Art Unit

2164



☒ Responsive to communication(s) filed on Nov 22, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-17 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 23

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2164

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35 US Code not included in this action can be found in a prior Office action(See Serial No: 08/999297, Paper No: 18). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.

2. This action is responsive to the amendment filed 11/22/00.

3. Claims 18-20 have been cancelled. No new claims have been added. Claims 1-17 have been amended by applicant.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 USC 103(a) as unpatentable over Schell(art of record) and further in view of Cahn(newly cited art).

Art Unit: 2164

6. As per claim 1, Schell teaches a catalog management software selection system that employs electronic data interchange(EDI) to connect various functions in the business system of Schell(page 147;col. 2; lines 45-50). The system of Schell contemplates international transactions(page 147;col 4 lines 15-40) that includes a language selection or determination to process transactions; determining a currency(page 148;col 2 lines 15-20)(page 148; col 4; lines 25-35), and determining products to be purchased and a destination for said products thereby triggering a calculation for all costs(bill to/ship to)(cols 3 & 4 of page 148). Schell also teaches automotive payment(page 4;col 4; lines 25-35) and the creation of an invoice(page 4;col 4; lines 35-55). Schell does not teach the triggering of an electronic funds transfer(EFT) authorization upon the purchase of a product. Schell does teach that even though its own system does handle credit card processing, the EDI function of Schell is "strong" and it is inferred that EFT would be possible(page 147;col 2;lines 45-50).Cahn teaches that in business systems implementing EDI, the use of EFT to transfer funds to a seller's account or financial institutions based on the buyer's authorization is old and well known. The advantages are increased cash flow, a reduction in float time, and an enhanced business relationship between customers and suppliers. The employment of an EFT system in Schell as claimed is obvious in view of Cahn for the advantages cited above.

Schell does not generate an electronic title(invoice) as claimed. Schell does teach the creation of an invoice(page 148;col 4). Applicant in his specification has equated ~~an~~ invoice with title.Cahn teaches using EDI to generate electronic invoices(electronic title)(Abstract, page 1; page 2). Cahn teaches the advantage of using electronic invoices to implement electronic title(electronic

Art Unit: 2164

invoices) to include streamlining the effort involved in the tracking processes. The use of an electronic invoice has been endorsed by the US Custom Service(Cahn, page 2) since it reduces the amount of time required for a shipment to clear through the customs process. The generation of an electronic invoice(electronic title) per Schell in view of Cahn for the benefits described here is obvious. Therefore the electronic invoice would be the electronic title and would define ownership. In view of the Customs Service endorsement, this method facilitates payment of taxes and duties as claimed. The process described by Schell and Cahn is implemented by EDI. EDI is an inter-company computer-to-computer communications system. This is used to implement business transactions in a standard format. Claim 1 cites that the business steps are implmented on the Internet. The EDI systems described in Schell and Cahn are dated 1991 and 1992, respectively. Similar to EDI, the Internet is a collection of computers that are linked. It is the position of the examiner, that to take a series of business steps implemented by EDI and perform these identical business steps employing the Internet would be an obvious use of current technology.

Specifically delineating the points in the Applicant's amendment, with respect to Claim 1(a) Schell teaches determining a language(col 4 lines 35-36) in which to view catalogue information on products. In reference to Claim 1(b) Schell teaches determining a currency(page 148 col 2 lines 15-20)(page 148 col 4 lines 25-35). In Claim 1(c), the system of Schell selects products to be purchased and a destination for said products thereby triggering a calculation for all costs(bill to/ship to)(cols 3 and 4 of page 148). With respect to Claim 1(d) Schell also teaches

Art Unit: 2164

accessing at least one or more databases for at least one of the following items:(i) price(page 148 col 3 lines 14-23),(ii) product codes,(iii) shipping information(page 148 col 3 lines 29-33) related to an origination point of said selected product and said destination. Additionally, Schell teaches according to Claim 1(e) calculating costs involved in moving said selected product to said destination based upon said destination and said product(page 148 col 3 lines 20-22)(page 148 col 3 lines 30-31). Concerning Claim 1(f), Schell teaches ordering products(col 4 lines 49-57, page 147), as well as the creation of an invoice(page 4/col 4 lines 35-55).Finally,Claim 1(g), utilizing Schell in view of Cahn, Schell teaches that electronic funds transfer is possible(page 147 col 2 lines 45-50).Moreover, in Schell modified by Cahn, when a purchaser orders a product and an electronic funds transfer is activated, inherently a confirmation of funds is accomplished or implied. This is a necessary part of the transaction.Once it is determined that the funds are present, and then transferred title is passed and the product is shipped to its destination and owner.

Cahn teaches that in business systems implementing EDI, the use of EFT to transfer funds to a seller's account or financial institution based on the buyer's authorization is old and well known (page 2 lines 1-5).Additionally EDI as addressed by Cahn is as an alternative to paper based transactions (page 3 paragraph 5). It would have been obvious to one skilled in the art at the time of the invention to combine Schell in view of Cahn to teach the applicant's amended claim 1(g). The motivation is increased cash flow, reduction in float costs, and enhanced business relationships between suppliers and customers.Furthermore, Cahn teaches the advantage

Art Unit: 2164

of using electronic invoices to implement electronic title(electronic invoices)as well as teaching using EDI to generate electronic invoices(Abstract, page 1;page 2). The generation of an electronic invoice(electronic title) combining Schell in view of Cahn for the benefits discussed here are obvious.

It appears that applicant argues that title is transferred upon the coinfirmation of the availability of funds, yet for the title to transfer, the funds need not be released. The scope of the language employed in Claim 1 is not limited to transfer of title upon solely the confirmation of the availability of funds.

7. With regard to claims 2-12 the various business methods described in these claims are well known techniques. Thus they are considered obvious.

8. With regard to claim 13, Schell discloses a software program(Business 400) for handling order entry, order processing,inventory managment,accounting and reporting functions, all of which one of ordinary skill in theart would recognize as requiring access to a database and passing related information. Furthermore, in view of the complete set of import/export processing routines available in Business 400, one of ordinary skill in the art would have found it obvious that the import/export data could be routed electronically to the various points.

Concerning Claim 13(a) Schell teaches computer to computer operation over the Internet for accessing one or more databases for at least one transaction. Schell teaches the transactions of price(col 3 lines 14-23, page 148) and shipping information(page 148, col 3 lines 29-33).With respect to Claim 13(b), Schell teaches a means for confirming available funds for a transaction

Art Unit: 2164

(page 148 col 3 lines 17-19). In respect to Claim 13(c), Schell teaches that electronic funds transfer is possible (page 147 col 2 lines 45-50). Cahn teaches that in business systems implementing EDI, the use of EFT to transfer funds to a seller's account or financial institution based on the buyer's authorization is old and well known (page 2 lines 1-5). Additionally EDI as addressed by Cahn is as an alternative to paper based transactions (page 3 paragraph 5). It would have been obvious to one skilled in the art at the time of the invention to combine Schell in view of Cahn to teach the applicant's amended claim 13(c). The motivation is increased cash flow, reduction in float costs, and enhanced business relationships between suppliers and customers. Furthermore, Cahn teaches the advantage of using electronic invoices to implement electronic title (electronic invoices) as well as teaching using EDI to generate electronic invoices (Abstract, page 1; page 2). The generation of an electronic invoice (electronic title) combining Schell in view of Cahn for the benefits discussed here are obvious. Finally, in regard to Claim 13(d) Cahn teaches that information from a shipping originator must include an invoice number and date, as well as shipment origin and destination (page 2 paragraph 8). Sending an invoice to a purchaser implicitly routes the invoice as the invoice travels with the goods and thus follows the same trajectory as the goods.

It appears that applicant argues that title is transferred upon the coinfirmation of the availability of funds, yet for the title to transfer, the funds need not be released. The scope of the language employed in Claim 1 is not limited to transfer of title upon solely the confirmation of the availability of funds.

Art Unit: 2164

9. With respect to claims 14-17, the business methods discussed in these claims are considered obvious and are well-known. Thus there is no novelty or nonobviousness implied in these claims.

Response to Arguments

10. Applicant's arguments filed 11/22/00 have been fully considered but they are not persuasive. Subsequent to the last Office Action and prior to applicant's latest amendment, three(3) interviews were held. These interviews were conducted on 10/26/00, 10/31/00, and 11/2/00 and respectively appear as Papers 19,20,21 in the file of this application.

The amendments to the claims do not place the application in a condition for allowance. A review of the Interview Summary records indicates that no such promise or agreement was ever made. In the interview of November 2,2000, the examiner stated that the art of record did not teach the generation of title "solely" upon the confirmation of the existence of funds. The claims do not include the term "solely".

Applicant has equated electronic title with commercial invoice (page 28 col 10-11/specification). Applicant further cites that paper copies of the "title or commercial invoice"(page 28 lines 11-12/specification) can be generated from the electronic original, indicating that the title as defined in this specification is just the electronic version of a standard industrial commercial invoice. Indeed applicant states(page 29 line 7/specification) that this is an "electronic commercial invoice".

Art Unit: 2164

Applicant, in his latest response, notes that in international business transactions the term “authorization” means funds are available and can be transferred “once the provisions of the purchase agreement have been satisfied” (page 10 paragraph 2). Nowhere is it stated or known that standard business practice involves the shipment of goods solely on the knowledge of the existence of funds which is what applicant alleges (page 11 paragraph 1) in his response, without regard to, or before, the satisfaction of the provisions of the purchase agreement (page 10 paragraph 2).

Applicant continues by stating that electronic title “conveys ownership” (page 12 line 1/response). Yet applicant then states that the electronic title is a commercial invoice (page 28 lines 10-11/specification) as cited above, but ownership cannot be conveyed without all terms of a contract being satisfied (page 10 paragraph 2). Thus applicant’s current arguments contradict what is originally disclosed in the specification. Applicant supports examiner’s position on page 13 paragraph 2) where it is stated under the terms of the UCC Article 1 Part 2 Section 1-201, a document of title “constitutes evidence of ownership”.

Applicant now argues that electronic title is generated “solely” upon “confirmation” of the existence of funds (page 12 paragraph 1 and 2/response). Moreover, the limitation of an electronic title generated “solely” upon confirmation of the existence of funds is not found in the specification as originally filed and would be considered new matter if added by amendment. Finally, applicant’s characterization of the electronic title as enunciated on (page 14 paragraph 1/response) is essentially that of an electronic commercial invoice.

Art Unit: 2164

11. Applicant's Information Disclosure Statement has been reviewed and entered. Shavit has been cited to teach a global business system for interactive on-line electronic communications and processing of business transactions between a plurality of different types of independent users including a plurality of buyers and sellers as well as financial institutions, and freight providers. This patent predates the enclosed application.

12. In the claims applicant has replaced the term "selecting" with the term "determining". The specification provides no antecedent basis for the new term and applicant must amend the specification accordingly.

Conclusion

132. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


Art Unit: 2164

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any questions regarding this communication should be addressed to the examiner, Dr. Geoffrey Akers, P.E. who can be reached at (703)-306-5844 between the hours of 6:30 AM and 5:00 PM Monday through Friday. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Vincent Millin may be telephoned at (703)-308-1065.

GRA

January 9,2001


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100